

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DANIELA GIACCHETTI and GILLES RUBINSTENN



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Appeal No. 2006-1544  
Application 10/024,621

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ON BRIEF

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Before FRANKFORT, BAHR and FETTING, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 69, all of the claims pending in the application.

Appellants' invention relates to a system and method for providing guidance for a subject (user). More particularly, as noted on page 1 of the specification, the invention uses profile information about a subject together with a birth-related classification, such as an astrological horoscope sign of the subject, as a basis for providing beauty advice to the subject. Independent claims 1, 36, 53, 55, 56, 59 and 67 are representative

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of the subject matter on appeal and a copy of those claims can be found in the Claims Appendix attached to appellants' brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Nordbye	3,936,957	Feb. 10, 1976
Williams	3,968,661	Jul. 13, 1976
Shim	2003/0078854 A1	Apr. 24, 2003
Maloney et al. (Maloney)	WO 01/18674 A2	Mar. 15, 2001

Claims 1 through 69 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In the examiner's view, these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 4 through 6, 9 through 15, 17 through 20, 24 through 27, 29 through 36, 43 through 47, 51 through 53, 56, 59 through 62 and 64 through 67 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Maloney.

Claims 2, 3, 7, 8, 16, 28, 37 through 42, 54, 55, 57, 58, 63, 68 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maloney in view of Shim.

Claims 21 through 23 and 48 through 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maloney in view of Shim, further in view of Nordbye and Williams.<sup>1</sup>

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the answer (mailed October 21, 2005) for the examiner's reasoning in support of the rejections, and to appellants' brief (filed August 1, 2005) and reply brief (filed December 21, 2005) for the arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 1 through 69 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure. It is by now well-established law that the test for compliance with the enablement requirement in the first paragraph of 35 U.S.C. § 112 is whether the disclosure, as filed, is

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<sup>1</sup> As noted on page 4 of the examiner's answer, the rejection of claims 1 through 55 and 67 through 69 under 35 U.S.C. § 101 set forth in the final rejection has now been withdrawn.

sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. See, In re Moore, 439 F.2d 1232; 169 USPQ 236 (CCPA 1971). Note also, In re Scarbrough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974) and In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Moreover, in rejecting a claim for lack of enablement, it is also well settled that the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement in order to substantiate the rejection. See In re Strahilevitz, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). Once this is done, the burden shifts to appellant to rebut this conclusion by presenting evidence to prove that the disclosure in the specification is enabling. See In re Doyle, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973).

In the case before us, after reviewing the rejection, appellants' arguments in the brief and reply brief, and the disclosure as set forth in the specification, we are of the opinion that the examiner has not met his burden of advancing acceptable reasoning inconsistent with enablement. The examiner's position as set forth in the answer (page 4) is that

[t]he Claims recite *providing beauty advice being a function of an astrological horoscope sign of the subject*. However, the relationship between *astrological horoscope sign*

and a *beauty product* is not clear. The specification does not provide any indication of how an *astrological horoscope sign* and a *beauty product* are interrelated. Furthermore, the examiner points out that knowledge in *astrology* and *cosmetic industry* is of such a different nature that it is not possible to envision how one would arrive to choosing a beauty product for a person based on knowing a horoscope sign of the person. Therefore, the functionality connecting the method steps of: "receiving astrological horoscope sign of a consumer" and "recommending to the consumer a beauty product", which is critical or essential to the practice of the invention, is not included in the Claims and is not enabled by the disclosure.

Although it is true that appellants have not provided details as to exactly how a particular astrological horoscope sign would be correlated to particular beauty advice or to a beauty product, we note that on page 15 of the specification (paragraph [054]) it is indicated that "physical or electronic look-up tables may be maintained, that correlate specific guidance with combinations of profile information and astrological horoscope signs." It is also noted in paragraph [055], bridging pages 15 and 16, that such look-up tables may be configured so that the same piece of guidance may correlate to multiple combinations of profile information and horoscope signs, and further that the look-up tables may change periodically, for example, by creating a new look-up table on a daily, weekly or monthly basis so that the provided guidance is always changing. Thus, it would appear that there may not be a concrete, unchanging correlation between a particular astrological horoscope sign and specific beauty advice or a particular beauty

product to be recommended. The correlation in such an instance would seem to be that which appellants decide is appropriate based upon known astrological principles when creating particular look-up tables, but once such tables have been established, then the guidance provided would clearly be "a function of at least some of" the subject's profile information and birth-related classification or astrological horoscope sign.

The specification goes on to note, in paragraph [058], that the provided guidance may alternatively be based on data stored on other individuals with similar profile information, e.g., an artificial intelligence engine may correlate the profile information on a subject with a database containing a plurality of pre-defined beauty advice records, with the correlation being made based upon past success with other individuals sharing similar profile information. Thus, the artificial intelligence engine would analyze a database to find a previously stored profile that best matches the profile information of the subject at hand and, once such a match is found, the same advice believed to be proven effective for an individual with similar traits would be dispensed to the subject in the form of guidance. In this instance, the initial advice given upon start-up of the system could be based on trial and error, at least until such time that a reasonable database of successful advice/guidance is

established for individuals with similar profile information and traits.

On the basis of the foregoing, it is our determination that one of ordinary skill in the art at the time of appellants' invention would have been able to make and use the invention as claimed without undue experimentation, e.g., by creating a particular set of look-up tables establishing a desired correlation between specific guidance and combinations of profile information and a birth-related classification, such as astrological horoscope signs, or by utilizing an artificial intelligence engine in the manner noted above to correlate the profile information on a subject with a database containing a plurality of pre-defined beauty advice records, with the correlation being made based upon past success with other individuals sharing similar profile information and astrological horoscope signs. In that regard, we also note that the examiner has provided no convincing explanation or line of reasoning as to why making and using a system and method like that described and claimed by appellants would have required undue experimentation. See, for example, MPEP § 2164.01 and 2164.01(a) for the factors to be addressed by the examiner in establishing that there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement, which factors do not appear to have been considered by the examiner.

For the above reasons, we will not sustain the examiner's rejection of claims 1 through 69 under 35 U.S.C. 112, first paragraph, as being based on a non-enabling disclosure.

We next consider the examiner's rejection of claims 1, 4 through 6, 9 through 15, 17 through 20, 24 through 27, 29 through 36, 43 through 47, 51 through 53, 56, 59 through 62 and 64 through 67 under 35 U.S.C. § 102(e) as being anticipated by Maloney. The examiner's position is set forth on pages 5-8 of the answer. Appellants' only point of contention with regard to the examiner's position is that Maloney's guidance in the form of a recommended list of beauty products is not arrived at as "a function of at least some of the profile information and [a]... birth-related classification" (brief, page 27). More specifically, appellants' contend that the examiner's attempt to equate the "life stage" information disclosed at page 7 of Maloney with appellants' "birth-related classification" recited in the claims on appeal is in error. Appellants urge that Maloney describes life stage as one example of psychological information, and that accordingly life stage refers to the periods of life with psychological impact, such as starting high school, going to college, marriage, and retirement, which is not the same as a birth-related classification, such as a subject's astrological horoscope sign (reply brief, page 6).



Giving the terminology "birth-related classification" its broadest reasonable interpretation consistent with the specification as one of ordinary skill in the art would understand it, we find that the examiner is correct. While appellants use the example of astrological horoscope signs as one form of "birth-related classification," we view that particular terminology much more broadly as also encompassing Maloney's "life stage" information. More particularly, while being a pre-teen, a teenager or a senior citizen is without doubt a "life stage" involving certain psychological aspects, they nonetheless also each represent a "birth-related classification." Moreover, appellants' own specification appears to support such a broad interpretation of the "birth-related classification" terminology. Note particularly, page 13 of the specification, wherein it is indicated that "birth-related classifications may include astrological horoscope signs, Karma, Numerology... [and] other classifications based on birth day, birth month, birth year, [etc]." In addition, in the same vein as Maloney, appellants' specification also indicates that such birth-related classifications "could be based more on emotional, social, and psychological factors than on hard science" (page 13, lines 10-11).

In the final analysis, and contrary to appellants' arguments, it is our determination that Maloney does provide guidance relating to beauty advice in the form of recommended beauty products based on

or as "a function of at least some of the profile information and [a]... birth-related classification" i.e., the life stage classification disclosed in Maloney.

Since we have found appellants' argument concerning the rejection of claims 1, 4 through 6, 9 through 15, 17 through 20, 24 through 27, 29 through 36, 43 through 47, 51 through 53, 56, 59 through 62 and 64 through 67 under 35 U.S.C. § 102(e) as being anticipated by Maloney unpersuasive, it follows that the examiner's rejection of those claims will be sustained.

The next rejection for our review is that of claims 2, 3, 7, 8, 16, 28, 37 through 42, 54, 55, 57, 58, 63, 68 and 69 under 35 U.S.C. § 103(a) as being unpatentable over Maloney in view of Shim. In this instance, the examiner has recognized that Maloney does not specifically teach using a subject's astrological horoscope sign as one of the elements of user information collected in building a personalized user profile to be used in placing the user in a customer profile category and ultimately for recommending beauty advice or a beauty product to the user based on the collected information. To address this difference, the examiner turns to Shim, urging that it discloses a method and system for providing advertisements and sales coupons over a network or the Internet, wherein consumers are classified based on personal profile information into a type grouping (Fig. 8) and where the selected

advertisements and/or sales coupons are sent based on such grouping classification. The personal profile information collected in Shim, like in Maloney, includes items relating to finances, hobbies, social activities, physical characteristics and emotional or character type, wherein the character type includes or is derived from input of information such as a subject's western or oriental zodiac sign, blood type, birthday, etc. (see, e.g., pages 9 and 10 of Shim). From the disclosures pointed to in the applied prior art references, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to modify Maloney to also use inputs regarding a subject's birthday or zodiac sign in recommending beauty advice or a beauty product to a subject, thereby enhancing the effectiveness of the advertising and reducing costs due to a more targeted campaign, as taught or suggested in Shim.

We agree with the examiner. Contrary to appellants' assertion that the examiner has not provided any "substantial evidence" to support the combination of Maloney and Shim (brief, page 32), we note that both of the applied references are interested in the personalized sale of products and/or services via a network, the Internet or otherwise, and both collect personal profile information on a subject which includes physiological, psychological and attitudinal information about the subject. The goal in both Maloney

and Shim is to then have a central server analyze the inputted information and place the subject into a particular consumer category, so that specific targeted marketing recommendations, sales coupons and advertisements can be sent to the subject based on the analyzed information. Both Maloney and Shim address the marketing of beauty products and services. See, e.g., Maloney, page 6, line 36, and Shim paragraph [068].

In addition, Maloney (page 9) also specifically indicates that the preferred consumer psychological and attitudinal information collected may include "personality information." Shim likewise expressly notes the importance of such user emotional and character type information in helping to target marketing data to a selected group of consumers and specifically teaches using western or oriental zodiac signs as part of the information collected and evaluated in arriving at a personality type consumer category (Shim, pages 9-10). Shim, page 10, paragraph [0201], specifically notes that such an approach "improves the decreasing effect of whole advertisement cost and advertisement effect because [it]... displays the advertisement only to suitable users according to character type."

Thus, to the extent that having the astrological horoscope sign of a subject would permit better evaluation of personality information and thereby better allow the system and method to

catagorize a subject so that targeted marketing data can be sent to only those most likely to be receptive to it, as is taught in Shim, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to use that same type of information in Maloney in recommending beauty products and services to a subject, thereby enhancing the effectiveness of the advertising and reducing costs due to the more targeted nature of the campaign.

Since we have found appellants' arguments unpersuasive, and since we have determined that the applied prior art would have been suggestive of the invention as a whole set forth in claims 2, 3, 7, 8, 16, 28, 37 through 42, 54, 55, 57, 58, 63, 68 and 69 within the meaning of 35 U.S.C. § 103, we will sustain the examiner's rejection of those claims.

The last of the examiner's rejections for our review is that of claims 21 through 23 and 48 through 50 under 35 U.S.C. § 103(a) based on the combined teachings of Maloney, Shim, Nordbye and Williams. In this instance, appellants have not specifically argued the examiner's reliance on Nordbye and Williams, but have again made the more general argument that the applied references do not teach or suggest the "providing guidance" step of independent claim 1, or the "dispensing guidance" step of independent claim 36, and further that the examiner's use of Nordbye and Williams does not cure the

deficiencies of Maloney and Shim. Given our findings and conclusions concerning the collective teachings of Maloney and Shim above, it is clear that this line of argument is not well founded, and thus is not persuasive of any error on the examiner's part. Maloney's use of a virtual image of a consumer depicting how the consumer would look after using a recommended beauty product (page 20) is responsive to the claim limitation relating to a prediction correlating the use of at least one beauty product with a predicted future occurrence. Accordingly, we sustain the rejection of claims 21 through 23 and 48 through 50 under 35 U.S.C. § 103(a).


To summarize: the examiner's rejection of claims 1 through 69 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is not sustained, however, the rejections of claims 1, 4 through 6, 9 through 15, 17 through 20, 24 through 27, 29 through 36, 43 through 47, 51 through 53, 56, 59 through 62 and 64 through 67 under 35 U.S.C. § 102(e) as being anticipated by Maloney, of claims 2, 3, 7, 8, 16, 28, 37 through 42, 54, 55, 57, 58, 63, 68 and 69 under 35 U.S.C. § 103(a) based on Maloney in view of Shim, and of claims 21 through 23 and 48 through 50 under 35 U.S.C. § 103(a) as being unpatentable over Maloney in view of Shim, Williams and Nordbye are sustained.

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Since at least one rejection of each of the claims on appeal has been sustained, it follows that the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under CFR § 1.136(a)(1)(iv).

AFFIRMED

  
CHARLES E. FRANKFORT )  
Administrative Patent Judge )

  
JENNIFER D. BAHR )  
Administrative Patent Judge )

  
ANTON W. FETTING )  
Administrative Patent Judge )

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